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PO BOX 1022
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte ROBIN U. SPERLE, SILKE A. H. GRUBER,
HOLGER BOHLE, MARCUS PHILIPP, HAGEN ECK, and
KATTIA JORDAN

Appeal 2015-001331
Application 11/257,589
Technology Center 3700

Before HUBERT C. LORIN, BRADLEY B. BAYAT, and
MATTHEW S. MEYERS, *Administrative Patent Judges*.

BAYAT, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants¹ appeal under 35 U.S.C. § 134 from the Examiner's final decision rejecting claims 1–30, which are all of the pending claims. We have jurisdiction under 35 U.S.C. § 6(b).

STATEMENT OF THE DECISION

We AFFIRM.

¹ According to Appellants, the real party in interest is SAP AG. Appeal Br. 1 (filed May 7, 2014).

CLAIMED INVENTION

Appellants' invention "relates to management and, more particularly, to monitoring progress of an external course." Spec. ¶ 1. Independent claim 1, reproduced below, is illustrative of the claimed subject matter on appeal.

1. A method, comprising:

transmitting, by a local learning management system configured to administer internal online courses developed by a first enterprise, a request to a remote learning management system to add an external online course to a course catalog provided by the local learning management system, the course catalog identifies the internal online courses provided online by the local learning management system and the external online course covers a subject different from subjects covered by the internal online courses and provided online by the remote learning management system, and the local learning management system, the remote learning management system, and learner devices include separate devices;

updating, by the local learning management system, an internal course catalog to identify the external online course as available for enrollment by users of the local learning management system in response to at least receiving information from the remote learning management system, the local learning management system configured to present the course catalog including the external course through remote learner devices;

automatically transmitting, by the local learning management system to the remote learning management system, a request to enroll a user in the external online course in response to at least a user selecting, through a learner device, the external course presented in the internal course catalog;

receiving, from the remote learning management system, tracking information identifying progress of the user in the external online course provided by the remote learning management system; and

updating a progress status for the user in the local learning management system based, at least in part, on the tracking information.

EVIDENCE

The Examiner relied on the following evidence in rejecting the claims on appeal:

Altenhofen et al. US 2003/0232318 A1 Dec. 18, 2003

THE REJECTIONS

Claims 1–30 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Altenhofen. Final Action 2–7 (“Final Act.,” mailed Dec. 19, 2013).

Claims 1–30 stand rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. Answer 2 (“Ans.,” mailed Sept. 12, 2014).

OPINION

Obviousness

Appellants argue the three independent claims (method claim 1, computer program product claim 11, and system claim 21) as a group. *See* Appeal Br. 7–8. We select claim 1 as the representative claim for this group. Thus, independent claims 11 and 21 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(iv).

Appellants contend that “the Examiner fails to consider at least the phrase ‘the external online course covers a subject different from subjects covered by the internal online courses and provided online by the remote learning management system.’” Appeal Br. 7. In particular, Appellants argue “that *Altenhofen* fails for at least the following two reasons: (1) the offline course and the online course disclosed in *Altenhofen* is provided by the same learning management system not different learning management systems; and (2) the offline course and the online course disclosed in *Altenhofen* are the same course not different.” *Id.*; Reply Br. 2 (filed Nov. 7, 2014).

We disagree that the Examiner relies on learning management system 623 for teaching both internal and external online courses. The Examiner rather finds that Altenhofen's learning station 610 includes a storage 760 for storing offline courses, wherein offline player 825 presents and manages the offline training using an offline player. Altenhofen ¶ 82; *see* Final Act. 2–3 (citing Altenhofen ¶¶ 82–84, 92–95, Fig. 8). Furthermore, the online and offline courses do not necessarily cover the same subject matter because a curriculum manager determines which content and courses may be provided offline by “indicat[ing] if a course also is offered offline.” *Id.* ¶ 86. As such, Appellants' arguments do not apprise us of error by the Examiner.

For the foregoing reasons, we sustain the rejection of claim 1 under 35 U.S.C. § 103(a), as well as claims 11 and 21, which fall with claim 1. Appellants do not contest the rejection of dependent claims 2–10, 12–20, and 22–30 under 35 U.S.C. § 103(a). Therefore, we summarily sustain the rejection of claims 2–10, 12–20, and 22–30.

Non-statutory Subject Matter

Regarding the new ground of rejection under 35 U.S.C. § 101 issued in the Answer, Appellants argue claims 1–30 as a group. Reply Br. 2–3. We select independent claim 1 as representative; the remaining claims stand or fall with claim 1.

Alice Corp. Pty. Ltd. v. CLS Bank Int'l, 134 S.Ct. 2347 (2014) identifies a two-step framework for determining whether claimed subject matter is judicially-excepted from patent eligibility under § 101. According to *Alice* step one, it must first be determined whether the claims at issue are directed to a patent-ineligible concept, such as an abstract idea. *Alice*, 134 S.Ct. at 2355. Step two is “a search for an [‘]inventive concept[’]--i.e., an

element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Alice* at 1297.

Appellants do not dispute the Examiner’s finding under *Alice*’s step one, but contend that the “claims are not so broad as to preempt all uses of the asserted abstract idea...[because they] are directed to a particular real-world implementation that does not preempt the very abstract idea itself.” Reply Br. 2. Appellants assert that the steps of claim 1 “are not mere instructions to implement the idea on a computer or are not a recitation of generic computer structure...[and when] viewed as a whole, provide meaningful limitations to at least transform the abstract idea into a patent eligible application of the abstract.” *Id.* at 2–3. We disagree.

The functions performed by the process in claim 1, i.e., transmitting...a request, receiving...information, and updating...data are routine, conventional, and well-known functions, and require nothing more than a generic computer performing generic computer functions. Claim 1 does not purport to improve the functioning of the computer itself. Nor does it effect an improvement in any other technology or technical field. Instead, claim 1 amounts to nothing significantly more than an instruction to implement the abstract idea on a generic computer — which is not enough to transform an abstract idea into a patent-eligible invention. *See Alice Corp.*, 134 S. Ct. at 2360. Indeed, it is telling that the Specification explicitly describes that the claimed method may be implemented using a general purpose personal computer (*see, e.g.*, Spec. ¶ 16).

Moreover, Appellants’ preemption argument does not alter our § 101 analysis. “The Supreme Court has made clear that the principle of

preemption is the basis for the judicial exceptions to patentability. *Alice*, 134 S. Ct. at 2354 (‘We have described the concern that drives this exclusionary principle as one of pre-emption[.]’). For this reason, questions on preemption are inherent in and resolved by the § 101 analysis.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015). Preemption concerns are, thus, fully addressed and rendered moot where a claim is determined to disclose patent ineligible subject matter under the two-part framework described in *Mayo* and *Alice*. Although “preemption may signal patent ineligible matter, the absence of complete preemption does not demonstrate patent eligibility.” *Id.*

In view of the foregoing, we sustain the Examiner’s rejection of independent claim 1 under 35 U.S.C. § 101. We also sustain the Examiner’s rejection of claims 2–30, which fall with claim 1.

DECISION

The Examiner’s decision to reject claims 1–30 is affirmed.

AFFIRMED